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REMARKS

Reconsideration and allowance are respectfully requested. Claims 1, 10, 18, and 22-24 have been amended. Claims 8 and 25 have been canceled. Claims 1-7, 9-24 remain pending.

The Examiner indicated that the claim for priority to U.S. Provisional Applications 60/208,664 and 60/280,679 is denied since, “Neither provisional applications appears to contain the text of the simulation software templates that appears in the Specification at pages 16-80.” Applicants submit that this application is entitled to priority to the above mentioned provisional applications. The Specification at page 16, first full paragraph states, “The process for building the simulation objects may be streamlined by creating templates in the simulation software for the simulation objects.” (emphasis added) The Specification then sets forth an example of a template for a simulation object.

With regard to the provisional applications not appearing to enable the claimed invention as required by 35 U.S.C. 112, first paragraph, nowhere in the specification does it state that use of templates is essential for practicing all embodiments of the invention. The code of pages 16-80 is merely a preferred embodiment of a method of the invention. Features which are merely preferred are not considered to be critical. In re Goffe, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976). The claims do not specify templates and hence, it is submitted that the provisional applications cited above fully support the claims and this application is entitled to the benefit of priority from the provisional applications.

The Examiner noted that the specification contains a computer program listing printout of more than 300 lines. A computer program listing appendix on a compact disc accompanies this Amendment. The specification has been amended to delete the listing therein and to provide the proper reference to the computer program listing appendix.

Claims 1-25 stand rejected under 35 U.S.C. 101. Independent claims 1, 10 and 18 have been amended to obviate the rejection. In particular, claims 1, 10 and 18 as

amended recite that the model is run on a computer. Thus, it is submitted that the claims utilize the technological arts. Therefore, the rejection should be withdrawn.

Claims 1-9 and 18-25 stand rejected under 35 U.S.C. 102(b) as being anticipated by Worhach et al. This rejection is respectfully traversed. Claim 1 has been amended to include the subject matter of claim 8 and claim 19 has bee amended to include the subject matter of claim 25. In particular, each of claims 1 and 18 as amended recites that the quantified benefit comprises a cost of ownership measure. The Examiner contends that Worhach et al. “calculates a cost of ownership measure corresponding to energy and waste consumption. See “IV. Case Study” at pages 222-224”. The modeling of Worhach et al. do not teach or suggest quantifying any benefit relating to cost of ownership. Worhach et al. merely compare aqueous and no clean process alternatives of a circuit board with regard to energy and waste generation. Energy and waste generation may be quantified in Worhach et al. but these parameters are not quantified with regard to any cost of ownership as claimed.

Hence, the rejection of claims 1-9 and 18-25 should be withdrawn because it fails to demonstrate that Worhach et al. disclose each and every element of the claim. See MPEP 2131. “The identical invention must be shown in as complete detail as is contained in the ... claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). “Anticipation cannot be predicated on teachings in the reference which are vague or based on conjecture.” Studiengesellschaft Kohle mbH v. Dart Industries, Inc., 549 F. Supp. 716, 216 USPQ 381 (D. Del. 1982), aff’d., 726 F.2d 724, 220 USPQ 841 (Fed. Cir. 1984).

Claims 10-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Worhach et al. in view of Puri. This rejection is respectfully traversed.

The preamble of claim 10 recites a “method for developing an electronics assembly equipment sales offer to a customer during a during a particular sales session”. This language clearly limits the claimed steps. As acknowledged in §2111.02 of the MPEP, “[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.” MPEP, Rev. 1, Feb. 2003, p. 2100-49 (citing Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989); Pac-Tec Inc. v. Amerace Corp., 903 F.2d 796,

801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990); In re Stencel, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987)). Worhach et al. do not teach or suggest sales offer to a customer during a particular sales session, but relates to modeling a particular circuit board assembly process for environmental impact.

The Examiner admits that Worhach et al. do not teach or suggest the claimed step of:

if the at least one performance measure satisfies the customer constraints, offering to sell at least a subset of the electronics assembly equipment of the configuration to the customer, wherein the offer is developed, with the benefit of the model, during the sales session.

The Examiner cites Puri as teaching “a system configuration that most nearly meets a customer’s needs based, on the results of an interactive customer product selection session...” and contends that it would have been obvious at the time the invention was made to modify Worhach et al. to perform the sales function and offer generation of Puri. Applicants respectfully disagree.

As noted above, Worhach et al. do not teach or suggest a sales offer to a customer, but relates to predicting and evaluating environmental characteristics of a production system. The result of the modeling of Worhach et al. is to optimize the parameters of a system for limited environmental impact, not to sell a subset of electronics assembly equipment to a customer. “Teachings of references can be combined only if there is some suggestion or incentive to do so.” In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). Thus, one would not look to Puri to modify Worhach et al. since there is no suggestion to offer anything for sale in Worhach et al. Thus, the rejection of claims 10-17 should be withdrawn.

All objections and rejections having been addressed, it is respectfully submitted that this application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



Frank J. Nuzzi
Registration No. 42,944
Attorney for Applicant

SIEMENS CORPORATION
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830
Tel. No. (732) 321-3002